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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/415,478 10/09/99 PRILLERMAN

K IP-354A

EXAMINER

QM12/0523

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ART UNIT

PAPER NUMBER

3711

DATE MAILED:

05/23/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/415,478

Applicant(s)

PRILLERMAN, KATHLEEN O.  
JOHNSON

Examiner

Benjamin H. Layno

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 2,3 and 18-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,5,8,12 and 14 is/are rejected.
- 7) ☒ Claim(s) 6,7,9-11,13 and 15-17 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 26-35\*\*, drawn to a method of playing a card game, classified in class 273, subclass 292.
  - II. Claims 1-25, drawn to a card game apparatus, classified in class 273, subclass 308.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the cards may be used as question cards for playing trivia games.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
4. This application contains claims directed to the following patentably distinct species of the claimed invention:
  - I. Method Of Play:
    - 1) Figs. 3-6, claims 32-35
    - 2) Figs. 1, 2, 7, 8, claims 27-31

II. Game Apparatus: 1) Figs. 3-6, claims 4-17

2) Figs. 1, 2, claims 2, 3, 18-25.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, in method of play claim 26 is generic, and in apparatus claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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5. In a letter filed by the Applicant on 3/01/00, the Applicant elected with traverse to prosecute the invention of Group II drawn to the game apparatus, and species 1) Figs. 3-6, claims 1 and 4-17. Claims 2, 3 and 18-35 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to the non-elected inventions.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Murray or Sturm et al.

8. The patent to Murray discloses an educational card game comprising a plurality of game cards 10 having a front side Fig. 1, and a back side Fig. 2. The front side has subject matter information including a U.S. map outlining the states. The back side has factual information 17, 18, relating to one of the states 12 shown on the front side.

9. The patent to Sturm et al. discloses an educational card game comprising a plurality of game cards 10 having a front side Figs. 1a, 1b, and a back side Fig. 2. The front side has subject matter information including a pictorial representation of a subject matter information 20 including a picture of a person. The back side has factual information 40, 43, 45 relating to the person on the front side.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murray.

11. In regard to the claimed "100 game cards" and "106 game cards", Murray recites "each accentuated section of the map indicia designated by the reference character 13 indicating a particular city, county or some other subdivision", page 1, lines 78-83.

There are at least 106 cities, counties, etc. in the U.S. Thus, it would have been obvious to provide at least 106 game cards to Murray's game, each game card representing a different city or county in the U.S. This modification would have kept Murray's game interesting by avoiding picking the same card twice in the same game. Furthermore, this modification would have educated players in learning about the U.S. cities or counties while playing Murray's game.

12. In regard to the claimed "STATE & CAPITALS" and "AFRICAN NATIONS & CAPITALS" imprinted on the front side, these are simply titles of the game. The only difference between claimed titles "STATE & CAPITALS", "AFRICAN NATIONS & CAPITALS" and Murray's title "THE NEW STATES GAME" resides in the meaning and information conveyed by printed matter. Such differences are considered unpatentable, *Ex parte Breslow*, 192 USPQ 431.

13. Claims 8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sturm et al. In regard to the claimed 92 and 100 game cards, Sturm recites "section 20 bearing the likeness of a U.S. political figure", column 5, lines 39-40. There are at least 100 U.S. political figures. Thus, it would have been obvious to provide at least 100 game cards to Sturm's game in order to keep the game interesting, and to avoid picking the same card twice in the same game.

14. In regard to the claimed "INVENTORS & INVENTIONS" and "TRUTH FACT MATCH" imprinted on the front side, these are simply titles of the game. The only difference between claimed "INVENTORS & INVENTIONS", "TRUTH FACT MATCH" and Sturm's game title resides in the meaning and information conveyed by printed matter. Such differences are considered unpatentable, *Ex parte Breslow*, 192 USPQ 431.

***Claim Rejections - 35 USC § 112***

15. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

16. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 5 is indefinite. It seems that on line 4 "state" should be changed to "capital", and on line 6 "capital" should be changed to "state".

***Allowable Subject Matter***

17. Claims 6, 7, 9-11, 13 and 15-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

18. Claim 5 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

19. The following is a statement of reasons for the indication of allowable subject matter: None of the cited references alone or in combination teach the claimed total number of game cards, wherein, on the back side, half the total number of cards have a name of a name or fact in the center of the card, and a name of a corresponding matching fact in the lower right hand corner, and, on the back side, the other half of the total number of cards have a matching fact in the center, and a name or fact in the lower right hand corner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin H. Layno whose telephone number is (703) 308-1815. The examiner can normally be reached on Monday-Friday, 1st Friday Off.

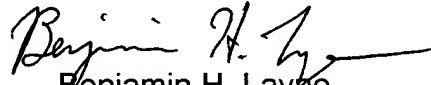
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeanette Chapman can be reached on (703) 308-1310. The fax phone numbers for the organization where this application or proceeding is assigned are (703)



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305-3579 for regular communications and (703) 305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

  
Benjamin H. Layno  
Primary Examiner  
Art Unit 3711

bhl  
May 17, 2001